

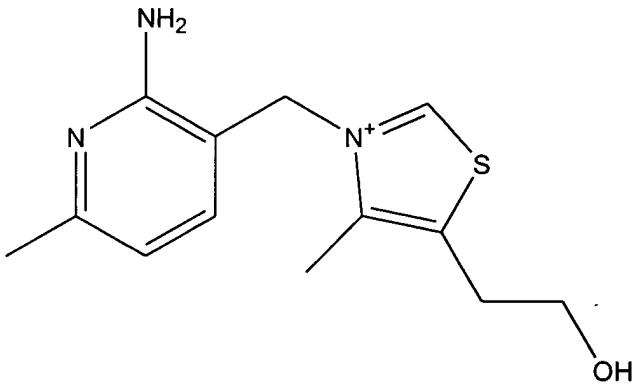
REMARKS

Claims 1-3, 5, and 7-27 are pending in the application. Claims 8 and 18-27 are hereby cancelled. Applicants expressly reserve the right to re-file cancelled claims 8 and 18-27 in one or more divisional applications.

New claims 28-30 are hereby added. Adequate support for new claims 28-30 and for each of the claim amendments made herein is found in the specification of the instant application as originally filed.

In response to the restriction requirement imposed in the Office Action dated November 20, 2009, Applicants elect with traverse to prosecute the invention of Group I, claims 1-3, 5, and 7-17, drawn to a compound of formula I where none of R¹, R², R³, and R⁴ contain cyclic groups, R⁵ and R⁶ are H, R⁷, and R⁸ are H, alkyl, or haloalkyl, R⁹ does not contain a cyclic group, antibody, polysaccharide, or peptide, R^a and R^b are H or OH, and R^c and R^d are H. Claims 1-3, 5, 7, 9-17, new claim 28 species (a)-(e), and new claims 29 and 30, as pending or as amended herein, conform to this election.

Applicants further elect with traverse to prosecute a species of group I, wherein the species has the chemical structure:



In the elected species (new claim 28 (species (a) and new claim 29), R¹ is -N(R)₂ where R is R^o is H; R² is alkyl; R³ is H; Y is C(R⁴) where R⁴ is H; R⁵ and R⁶ are H; R⁷ and R⁸ are H; R^a and R^b are H; R^c and R^d are H; R⁹ is OR¹⁰, where R¹⁰ is R^o is H; and n is 1.

Claims 1-3, 5, 7, 9-14, 16, and 17, and new claims 28-30, as pending or as amended herein, read on the above elected species.

In addition to examining the elected chemical species of new claim 28 (species (a)) and new claim 29, Applicants respectfully request that the Examiner examine all of the species of new claim 28 (including species (b)-(f)) and the sub-genus of new claim 30, which encompasses the elected species and each of the species of new claim 28.

Species (b)-(f) of new claim 28 have the same pharmacore as elected species (a) of claim 28 and differ from the elected species only by a single substitution (e.g., for species (c) of claim 28, R⁷ is methyl instead of H). The relatively limited number of species of new claim 30 reflect the minor substituent variations between each of the species of new claim 28. Therefore, as explained below, the elected species and the other species covered by new claims 28-30 are each part of the same invention.

It is well settled that claims to compounds that have an identical nucleus (pharmacore), a variety of substituents, and a common utility, are part of a single invention. The alleged burden of searching such an invention in different fields of search and different search classifications plays absolutely no role in the determination of unity *vel non*. *See In re Harnisch*, 206 U.S.P.Q. 300 (CCPA 1980). The claimed compounds must be considered as a whole, and not separately based on the different substituents on the common central nucleus (pharmacore).

There is a unity of invention where, as in the case of the species of new claims 28-30, the central nucleus (pharmacore) is identical, especially if – as here - all of the compounds have a common utility and function, belong to a common, recognized genus, and share a community of properties. *See ex parte Brouard*, 201 U.S.P.Q. 538 (Bd. App., 1976). The determination of unity of invention does not *require* that there be a community of properties (although in the present application, this happens to be the case), as long as the covered compounds have a common nucleus which would exhibit certain characteristics. *See ex parte Taylor*, 167 U.S.P.Q. 637 (Bd. App., 1969).

It is unequivocal that as long as all of the compounds have a common nucleus, they represent a single invention regardless of the number and type of substituents on that common nucleus and the alleged burden of searching the invention in different fields of search. Further, it is also clear that different search classifications play no role in the

determination of unity of invention. It is respectfully submitted that a restriction requirement with respect to species (b)-(f) of new claim 28 and/or the proposed sub-genus of new claim 30 would be improper and Applicants respectfully request the Examiner to issue a first office action or a notice of allowance on the merits without further restriction.

Notwithstanding the presentation of the elected invention and species and proposed additional species and sub-genus, Applicants respectfully request that the Examiner withdraw his restriction requirement in its entirety since examination of all of the originally filed claims may be made in conformity with applicable law and regulations. For the reasons provided below, it is respectfully submitted that examination of all of the originally filed claims would not be overly burdensome and withdrawal of the restriction requirement is appropriate.

According to MPEP § 803, restriction of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the Examiner if restriction was not required. Applicants respectfully submit that the presentation of all of the originally filled claims did not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related though similar compositions and methods, have a common utility, and are readily searched without undue effort.

Although the claimed invention groups are generally patentably distinct from each other, Applicants maintain that any search the Examiner would need to conduct in examining the instant application and the examination itself would not be unduly burdensome. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction. When the general policy considerations for the Patent Office's requirement for restriction in certain instances are balanced against the administrative efficiency of examining all of the readily searchable invention groups (I)-(XXX), it becomes clear that withdrawal of the outstanding restriction requirement is proper.

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Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in MPEP § 803. Consequently, Applicants respectfully request that the Examiner withdraw the restriction requirement in its entirety.

The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

If any fee is due or any overpayment has been made in connection with the presentation of this response, please debit or credit Deposit Account 04-0838.

Respectfully submitted,

COLEMAN SUDOL SAPONE, P.C.

By:

Henry D. Coleman
Reg. No. 32,559

Kevin J. McGough
Reg. No. 31,279

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714 Colorado Avenue
Bridgeport, CT 06605-1601
203-366-3560

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: "Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on February 11, 2010.

Henry D. Coleman (Reg. No. 32,559)